

Amended
a second filter coupled to said drain terminal via said resonant inductor circuit wherein the level of said output of said amplifier is approximately at RF ground potential and wherein the level of said output of said amplifier is not affected by said second filter.

REMARKS

The Examiner has objected to the drawings for not illustrating a "bipolar transistor." In response, Applicants have submitted a new Figure 1 illustrating the bipolar transistor and the insulated gate bipolar transistor, as directed by the Examiner, these are identified also by number 110 as inserts in the figure. Support for this amendment appears in the specification at page 10, lines 2-5, original claims 7 and 8, and elsewhere in the specification. No new matter has been added.

The Examiner has objected to the specification. Applicants have amended the specification at page 12, lines 20-22 for greater clarity. No new matter has been added. Entry and favorable consideration of the amendment are respectfully solicited.

The Examiner has also objected to claims 1, 21 and 34 for reasons unstated, requesting Applicants replace the wording "a filter" with "a first filter." Applicants have amended dependent claims 14, 32 and 45 to add "a first filter." Being the first claims that reference "second filters," Applicants deem it more appropriate to amend these claims for greater clarity. In addition, Applicants have amended claim 8 to correctly reference its dependency from claim 7. No new matter has been added. Entry and favorable consideration are respectfully solicited.

The Examiner has rejected claims 8, 11, 14, 17 and 18 under 35 U.S.C. §112, second paragraph, for failing to particularly point out and distinctly claim the subject matter

regarded as the invention. With respect to claim 8, Applicants' amendment to the dependency of this claim to rely on claim 7 resolves the contention that the wording "said bipolar transistor" has insufficient antecedent basis. Moreover, Applicants note that "insulated gate bipolar transistor" is recited in the specification at page 10, lines 2-5, and thus this wording is sufficiently definite in the claim. To this degree, Applicants traverse the Examiner's objection that this wording is unclear.

As to claims 11 and 14, Applicants submit the claim language is definite as recited, in that "filter" pertains to two low pass filters. Applicants therefore traverse this requirement.

As to claims 17 and 18, Applicants have deleted these claims, without prejudice. As such, the objections related to these claims are moot.

Rejection Under 35 U.S.C. §102

Claims 1-6, 9, 12, 13, 17, 21-27, 29, 31, 34-40, 42, and 44 were rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 6,300,830 issued to David R. Pehlke (hereinafter "Pehlke"). (Office Action, at pp. 4-5). For the reasons set forth below, the rejection is respectfully traversed.

As is well settled, anticipation requires, "identity of invention." *Glaverbel Societe Anonyme v. Northlake Mktg. & Supply*, 33 USPQ2d 1496, 1498 (Fed. Cir. 1995). Each and every element recited in a claim must be found in a single prior art reference and arranged as in the claim. *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). There must be no differences between what is claimed and what is disclosed in the applied reference. *In re*

Kalm, 154 USPQ 10, 12 (CCPA 1967); *Scripps v. Genentech Inc.*, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

Pehlke teaches “a circuit for providing a multiplexed input to an amplifier load matching network.” (Abstract). The circuit includes a control device and a plurality of switching devices in communication with the control device and the amplifier. (Abstract). Thus, the circuit creates a “quantized waveform based on received phase and amplitude information from an input signal.” (Summary of Invention).

At the very least, Pehlke fails to disclose a resonant inductor for eliminating the capacitance between two conducting terminals when the semiconductor device is in its nonconductive or off state as claimed in claims 1, 21 and 34. Rather, the Examiner merely states that “a voltage supply together with inductor can be read as a resonant inductor.” (Emphasis added). How this “can be read” as disclosing the resonant inductor, as claimed by Applicants, is not provided or explained. This characterization, even if apt, which Applicants believe it is not, fails to demonstrate that Pehlke discloses the claimed limitation as arranged in the claim. For this reason alone, the Examiner has failed to meet his burden.

Moreover, merely stating that a “filter” is disclosed in Pehlke, does not account for the filter as it is claimed with all of its limitations. In fact, Pehlke fails to disclose a filter providing controlled impedance to signals or filtering signals outside of a predetermined frequency band.

For the reasons provided above, Pehlke does not disclose each and every limitation of claims 1, 21 and 34, these claims being the sole independent claims from which all other claims in the application depend. Because the limitations of these independent claims are necessarily present in all claims dependent therefrom, Pehlke likewise does not anticipate claims

2-6, 9, 12, 13, 17, 22-27, 29, 31, 35-40, 42, and 44. Applicants respectfully request reconsideration and withdrawal of the rejection.

Rejection Under 35 U.S.C. §103

Claims 7, 10, 11, 14-16, 19, 20, 28, 30, 32, 33, 41, 43, 45, and 46 were rejected under 35 U.S.C. §103(a) as anticipated by U.S. Patent No. 6,300,830 issued to David R. Pehlke (hereinafter “Pehlke”). (Office Action, at pp. 5-6). For the reasons set forth below, the rejection is respectfully traversed.

Pehlke has been discussed with respect to the rejection under §102 and Applicants’ traversal thereof.

In order to establish a *prima facie* case of obviousness the cited references must teach every element recited in the claims and identify the necessary motivation to combine these elements. In re Rouffet, 149 F. 3d 1350; 47 USPQ2d 1453 (Fed. Cir., 1998). Statements with regard to relevant skill in the art do not suffice to “bridge over gaps in substantive presentation of an obviousness case.” Al-Site Corp. v. VSI International, Inc., 174 50 USPQ2d 1161 (Fed. Cir. 1999). It is respectfully submitted that the cited reference fails not only to disclose or teach each element of the Applicants’ claims, they also fail to provide the requisite suggestion *to do* what the Applicants have done. For these reasons alone, the rejection of the claims is insufficient as a matter of law. Ex parte Levengood, 28 USPQ2d 1300, 1301-02 (BPAI 1993).

Moreover, the Examiner sets forth the rejection under §103 in a manner that presumes Pehlke discloses all elements of the underlying independent claims. Applicants have previously demonstrated with respect to the § 102 rejection that this is not the case. For this reason alone the rejection fails. Furthermore, the Examiner’s statement that each additional element in the claims that may be unaccounted for by Pehlke are either “known in the art” or “a

matter of design choice.” By these statements, the Examiner fails to carry his burden of demonstrating obviousness, as there is no showing whatsoever of any teaching, motivation or suggestion that such elements would be combined with the disclosure of Pehlke. In this regard, Applicants request the Examiner set forth particularly where in Pehlke the Examiner finds the relevant suggestion, motivation or teaching, if any, to, for instance, interchangeably include a FET or bipolar transistor, or use a KPT configuration, or use a second filter, in addition and in combination with the apparatus Pehlke discloses. Applicants assert there is none. Therefore, the rejection must fail.

Office procedure is clear. The citation must “suggest the desirability of the combination” that is claimed. See MPEP 2143.01 at 2100-110, 111 and MPEP 2145 (j) 3 at 2100-127. This MPEP section further requires that “Obviousness can only be established by combining or modifying the teaching of the prior art to produce the claimed invention where there is *some teaching, suggestion or motivation* to do so...” (Emphasis added). Merely using Pehlke as a springboard to encompass all elements of the Applicants’ claims because they are, in the Examiner’s estimation, “known in the art” utterly fails to establish a prima facie case of obviousness.

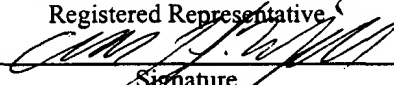
The Examiner’s opinion is not the relevant test of obviousness. Rather, the Examiner must ascertain whether or not the reference is sufficient for one of ordinary skill in the relevant art having the reference before him or her to make the proposed combination. *In re Linter*, 173 USPQ 560 (CCPA 1972). This is not a speculative exercise. This finding, as well as the rejection itself, must be based on facts, not generalities. *Ex parte Saceman*, 27 USPQ2d 1472, 1474 (BPAI 1993). The Examiner has not pointed to any specific facts to support his assertions. For this additional reason, the rejection must be withdrawn.

Consequently, the application as amended appears to be in condition for allowance and such action is respectfully requested.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on April 30, 2002
(Date of Deposit) Charles T. J. Weigell
Name of applicant, assignee, or Registered Representative 
Signature April 30, 2002 Date of Signature

“Marked-Up” Amendments to the Specification Pursuant to Rule 1.121(b)(1)(iii)

Page 12, line 21:

The resonator circuit [includes] 130 is coupled to a DC voltage source V3 of -
160 volts coupled in series with a choke inductor LCH of 23 μ h.

“Marked-Up” Claims Pursuant to Rule 1.121(c)(1)(i)

Please cancel claims 17 and 18, without prejudice.

8. (Amended) The RF amplifier of claim 7 [claim 6] wherein said bipolar transistor is an insulated gate bipolar transistor.

14. (Amended) The RF power amplifier of claim 1 wherein the filter is a first filter and further comprising:

a second filter coupled to said second conducting terminal via said resonant inductor circuit wherein the level of said output of said amplifier is approximately at RF ground potential and wherein the level of said output of said amplifier is not affected by said second filter.

Sub B3 32. (Amended) The RF power amplifier of claim 21 wherein the filter is a first filter and further comprising:

a second filter coupled to said source terminal via said resonant inductor circuit wherein the level of said output of said amplifier is approximately at RF ground potential and wherein the level of said output of said amplifier is not affected by said second filter.

In re Application of :
U.S. Serial No.:
For:

Ke S. GERRISH
09/031,879

VOLTAGE-CURRENT SENSOR FOR HIGH MATCHING DIRECTIVITY

45. (Amended) The RF power amplifier of claim 34 wherein the filter is a first filter
and further comprising:

a second filter coupled to said drain terminal via said resonant inductor circuit
wherein the level of said output of said amplifier is approximately at RF ground potential and
wherein the level of said output of said amplifier is not affected by said second filter.